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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,052	08/28/2001	Jorg Schlieffers	1206	5662
7590	06/10/2004		EXAMINER	
ALAN ISREAL KIRCHSTEIN OTTINGER ISREAL & SCHIFFMILLER 489 FIFTH AVENUE NEW YORK, NY 10017			LEE, DIANE I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/941,052	SCHLIEFFERS, JORG	
Examiner	Art Unit		
D. I. Lee	2876		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 May 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 26-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 26-31 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 28 August 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 17 May 2004. Claims 1-25 have been canceled and claims 26-31 have been newly added. Currently, claims 26-31 are pending in this application.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 5/17/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,123,265 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. [US 5,828,052-referred as Reynolds] in view of Evers et al. [US 6,036,096-referred as Evers] and Sakai [US 4,210,802, previously cited by the examiner].**

**Re claims 26-27:** Reynolds discloses a reader for electro-optically reading indicia (a scanner 20), comprising:

a housing having a body portion extending along a longitudinal direction to one end region (i.e., a head portion 22) of the housing, a light-transmissive window 64 at said one end region, and a handled portion 26 extending along a handle direction to an opposite end region of the housing (see figure 3);

a scanner (a scan engine, not shown, contained in the housing) mounted within the housing for electro-optically scanning the indicia with light passing through the window during a reading mode (see figure 5+), and wherein the scanner includes a trigger 60 on the handle portion for manually actuating the scanner when the handle portion is held by the user, thus, the trigger activating the scanner provides an operation transition from a non-reading mode to a reading mode (see col. 4, lines 20+ and figures 3-6);

a first resilient member (i.e., the upper bumper 34, 66 of elastomers to protect underlying surface of the scanner) mounted at said one end region and constituted of a hard rubber, thus the first resilient member constitute a first resting surface;

a second resilient member (i.e., lower bumper 34' and end cap 28) mounted at the opposite end region and extending away from the handle portion, said second resilient member having a bottom edge constituting a rear contact zone which, together with the first resting surface from the first resilient member, capable of simultaneously support the housing on a generally planar support surface when the handle portion is not held by a user (i.e., non-reading mode); and

an eyelet (i.e., an opening, shown in figures 5-6, 8-9 but the specific reference number not assigned) extending from the second resilient member, for alternatively supporting the housing when the handle portion is not held by the user (i.e., the opening at the end cap of the reader may be optionally used for suspending the reader from a support projection such as a nail, a hook, and etc. when not scanning or non-reading mode).

Although Reynolds shows the forwardly extending portion 66 of the first resilient member serves the claimed function for spacing the window at a given minimum distance from the indicia to be read (see figures 5-6, for example); Reynolds fails to show the specifics of the claimed first resilient member and the spacer, i.e., the first resilient member being an annular, surrounding the window, and having upper, lower and side edges extending along the longitudinal direction past the window away from the body portion, the side edges extending further from the window than the upper and lower edges to constitute a first resting surface; and the spacer is integral with the lower edges and is concavely curved.

Evers discloses a hand-held imager 10, comprising a housing 11 having a body portion extending along a longitudinal direction to one end region (i.e., a head portion 12, 20) of the housing, a light-transmissive window 22 at said one end region, and a handled portion 14 extending along a handle direction to an opposite end region of the housing (see figure 3). The hand-held imager having a scanner (a scan engine, not shown, contained in the housing) mounted within the housing for electro-optically scanning the indicia with light passing through the window (see figure 1). The hand-held imager further includes a first resilient member (i.e., an end cap 26) mounted at said one end region 12, 20 and constituted of a hard rubber (see col. 4, lines 8+). The first resilient member being an annular, surrounding the window, and having upper, lower and side edges extending along the longitudinal direction past the window away from the body portion to constitute a first resting surface (see figures 1-6). The hand-held imager further includes a spacer (the spacer is integral with the lower edges of the first resilient member) on the first resilient member for spacing the window at a given minimum distance from the indicia to be read in the reading mode and a second resilient member (i.e., end member 36 with a flexible coupling 72) mounted at the opposite end region and extending away from the handle portion, said second resilient member having a bottom edge constituting a second resting surface, which together with the first resting surface from the first resilient member, support the housing on a generally planar support surface when the handle portion is not held by a user (see col. 6, lines 32+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the specific structure of the first resilient member, as taught by Evers, in the system of Reynolds in order to improve the configuration shape of the scanner, i.e., improving the supporting surfaces that allow a secure positioning of the scanner on a flat surface or on a generally a planar surface whereby the handle can be grasped easily by an operator (see col. 2, lines 37+). Such modification in the construction of the housing would have ergonomically enhanced in manipulating and handling of the scanner.

Reynolds as modified by Evers fails to teach the side edges first resilient member extending further from the window than the upper and lower edges and constituting a pair of front contact zones spaced apart from one another.

Sakai teaches a bar code scanner 2 having a guide 23 engaged with the body portion 21 of the scanner 2 and wherein the guide 23 includes side edges extending further from the window than the upper and lower edges such that the side edges extending further from the window than the upper and lower edges can be a pair of front contact zones spaced apart from one another. Also, the specific spacing of the side edges encompass the bar codes 1a therebetween and automatically define a scanning region when the side edges are contacted with the record medium 1 (see col. 2, lines 52+ and figure 2A).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the side edges that extending further than the upper and lower edges in the teaching of Reynolds as modified by Evers in order to define a scanning region for the scanner when the side edges are rested on the record medium. Accordingly, such modification would have provided a consistency in obtaining an accurate reading.

**Re claims 28-29:** Reynolds as modified by Evers and Sakai fails to teach the upper and lower edges are convexly curved.

However, the specific shape of the upper and lower edges convexly curved would have been obvious design variation to provide variable shape and size of the components for an esthetic purpose, since such a modification would have involved a mere changing the shape and the size of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 UAPQ 237 (CCPA).

**Re claim 30:** Reynolds teaches the eyelet extends along the handle direction through the second resilient member (see figures 5-6 and 8-9).

**Re claim 31:** Reynolds and Evers both show the scanner body of the longitudinal direction of the body portion and handle directions of the handle portion form an obtuse angle with each other (i.e., the handle is slanted with respect to the head body).

### ***Response to Arguments***

5. Applicant's arguments filed 17 May 2004 have been fully considered but they are not persuasive.

6. In response to applicant's argument with respect to Sakai reference that the two extending side edges of the guide 23 do not contact a resting surface, but instead contact a record medium 1 on which a symbol 1a is printed (see page 4, lines 1+). The examiner respectfully disagrees. Sakai teaches a bar code scanner 2 having a guide 23 engaged with the body portion 21 of the scanner 2. The guide 23 includes side edges extending further from the window than the upper and lower edges. Sakai discloses that the specific spacing of the side edges encompass the bar codes 1a therebetween and automatically define a scanning region when the side edges are contacted with the record medium 1 (see col. 2, lines 52+ and figure 2A). Also, Sakai shows in figure 1 that the side edges that extend further from the window than the upper and lower edges can be a pair of front contact zones spaced apart from one another. Thus, the combined teachings of Reynold, Evers and Sakai obviously teaches the claimed structure of the scanner capable of providing contact zones simultaneously supporting the housing at three individual contact zones (i.e., a pair of front contact zones spaced apart from one another and one real contact zone of the scanner) spaced apart from each other on a generally planar resting surface in the non-reading mode when the handle portion is not held by a user.

1. With respect to the rejection on the merits, which applicant traverses the Examiner's determination of incorporating the specific structure of the first resilient member, as taught by Evers and the system of Reynolds in order to improve the secure positioning of the scanner on a flat surface because Reynolds suggest placing the scanner in a support cradle 82 or a support fixture 90 when the scanner is not being held by a user (see page 4, lines 10+). The examiner respectfully disagrees. Whether the

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scanner is placed on a planar resting surface or in a support cradle or a support fixture when a user is not holding the scanner, it is an obvious intended use of the scanner. The fact that there is no structured difference between the claimed scanner and the prior art, and the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, applicant's argument on this point is not persuasive.

### ***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee  
Primary Examiner  
Art Unit 2876

D. L.